

Remarks/Arguments

Claims 1-17 are pending in this application and are rejected in the final Office Action of May 17, 2006. The specification is amended herein to claim the benefit of earlier filing dates. No claim amendments are presented in this response.

Rejection of claims 1-17 under the judicially created doctrine of obviousness-type double patenting based on claims 1-3, 6, 8 and 11 of Stahl et al. (U.S. Patent No. 6,665,020) in view of Ludtke et al. (U.S. Patent No. 6,593,937)

Applicants submit that this rejection is moot since Ludtke et al. '937 can not be applied as a prior art reference against the present invention. The reference date of Ludtke et al. '937 is the provisional application filing date of June 18, 1998. The present application is based on PCT application US98/19483 filed September 18, 1998, which claims the benefit of U.S. provisional applications 60/059,507 filed September 18, 1997, 60/066,782 filed November 25, 1997, and 60/071,341 filed January 14, 1998. All of the provisional applications to which the PCT application claims the benefit predate the provisional application filing date of Ludtke et al. '937. The specification of this application is amended herein to include a reference to the aforementioned PCT application and three U.S. provisional applications and a claim for priority. Applicants submit that this amendment to the specification is proper and timely pursuant to 37 CFR 1.78 for the following reasons.

On page 2 of the final Office Action dated May 17, 2006, the Examiner alleges:

"[t]he required reference to the earlier provisional application must be submitted within the time period provided by 37 CFR 1.78(a)(5)(ii). This time period is not extendable." (emphasis original)

In response, Applicants note that the time periods provided by 37 CFR 1.78(a)(5)(ii) do not apply to this application. In particular, 37 CFR 1.78(a)(5)(ii) clearly states:

“The time periods in this paragraph do not apply if the later-filed application is:

.....

(B) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.” (emphasis added)

In this case, the later-filed application (i.e., this application) is a nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application (i.e., PCT application US98/19483) filed under 35 U.S.C. 363 on September 18, 1998 (i.e., before November 29, 2000). Accordingly, the time periods provided by 37 CFR 1.78(a)(5)(ii) do not apply to this application, and the amendment to the specification to include a reference to the aforementioned PCT application and three U.S. provisional applications and a claim for priority is deemed proper and timely. In view of this reference and claim for priority, Applicants submit that Ludtke et al. ‘937 can not be applied as a prior art reference against the present application.

The cited claims of Stahl et al. ‘020 are directed to a system of remote control command pass through. That is, an apparatus receives the remote control signals, maps the control information into a universal command format and transfers the mapped control information to a peripheral device. Nothing in the cited claims of Stahl et al. ‘020 teach or suggest the feature of transferring digital video content and digital OSD content as separate data via a digital bus. Accordingly, Applicants submit that claims 1-17 are patentably distinguishable over the cited claims of Stahl et al. ‘020, and withdrawal of the rejection is respectfully requested.

Rejection of claims 1-2, 6-7 and 11 under 35 USC 102(e) as being anticipated by Ludtke et al. (U.S. Patent No. 6,593,937)

Applicants submit that this rejection is moot since, for the reasons discussed above, Ludtke et al. ‘937 can not be applied as a prior art reference against the present application. Accordingly, withdrawal of the rejection is respectfully requested.

Rejection of claims 3-5 and 8 under 35 USC 103(a) as being unpatentable over Ludtke et al. (U.S. Patent No. 6,593,937) in view of Ludtke et al. (U.S. Patent No. 6,421,069)

Applicants submit that this rejection is moot since, for the reasons discussed above, Ludtke et al. '937 can not be applied as a prior art reference against the present application. Applicants further submit that Ludtke et al. '069 fails to teach or suggest each and every limitation of claims 3-5 and 8. Accordingly, claims 3-5 and 8 are patentably distinguishable over Ludtke et al. '069, and withdrawal of the rejection is respectfully requested.

Rejection of claims 10 and 17 under 35 USC 103(a) as being unpatentable over Ludtke et al. (U.S. Patent No. 6,421,069) in view of Ludtke et al. (U.S. Patent No. 6,593,937), and further in view of P1394 Draft 8.0v2

Applicants submit that this rejection is moot since, for the reasons discussed above, Ludtke et al. '937 can not be applied as a prior art reference against the present application. Applicants further submit that the proposed combination of Ludtke et al. '069 and P1394 Draft 8.0v2 fails to teach or suggest each and every limitation of claims 10 and 17. Accordingly, claims 10 and 17 are patentably distinguishable over the combination of Ludtke et al. '069 and P1394 Draft 8.0v2, and withdrawal of the rejection is respectfully requested.

Conclusion

Having fully addressed the Examiner's rejections it is believed that, in view of the preceding amendments and remarks/arguments, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicant's attorney at (609) 734-6815, so that a mutually convenient date and time for a telephonic interview may be scheduled.

Respectfully submitted,
Thomas A. Stahl, et al.

By: 
Paul P. Kiel
Attorney for Applicants
Registration No. 40,677

THOMSON Licensing Inc.
PO Box 5312
Princeton, NJ 08543-5312

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